

# Notice of Allowability

Application No.

10/786,810

Examiner

Yong S. Chong

Applicant(s)

BENAVIDES ET AL.

Art Unit

1617

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/16/2006.
2. ☒ The allowed claim(s) is/are 1,2,10,20,21,29, and 36.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

Yong S. Chong

## **EXAMINER'S AMENDMENT**

### ***Status of the Application***

This Office Action is in response to applicant's arguments filed on 11/16/2006. Claims 3-9, 11-19, 22-28, 30-34 have been cancelled. Claims 1-2, 10, 20, 29 have been amended. Claims 1-2, 10, 20-21, 29, 35-36 are pending.

Applicant's amendments have rendered the 112, second paragraph, rejections of the last Office Action moot, therefore hereby withdrawn.

The terminal disclaimer filed on 5/18/2006 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent 6,355,631 B1 has been reviewed and is accepted.

The terminal disclaimer filed on 11/16/2006 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent 7,105,504 B2 has been reviewed and is accepted.

The terminal disclaimer has been recorded. The obviousness double patenting rejections are hereby withdrawn.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Balaram Gupta on 2/5/2007.

The application has been amended as follows:

Claim 35 has been cancelled.

The claims are now in condition for allowance.

### ***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance: the pending claims are free of the art.

The closest prior art is Archard et al. (US Patent 6,355,631 B1) because the full scope of compounds of formula I is disclosed; whereas the instant claims are directed to a composition comprising compounds of formula I and dopaminergic agonists.

Claims 1-2, 10, 20-21, 29, 35-36 was rejected under 35 USC 103(a) as being obvious over Archard et al. (US Patent 6,355,631 B1) in view of Durif et al. (US Patent 5,562,917). Since US Patent 6,355,631 B1 is a 102(e) reference in a 103(a) rejection, Applicant has overcome this rejection by claiming common ownership at the time the invention was made.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

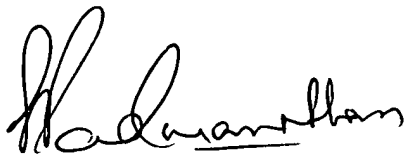
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER